

REMARKS

The Examiner rejected independent claims 1, 12 and 17 under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,499,775 to Vander Groef ("Vander Groef") in combination with U.S. Patent Application No. 2001/0039190 to Bhatnagar ("Bhatnagar"). Claim 1 recites a wire winding machine with a portable operator console.

Admitting that Vander Groef does not disclose a portable wire winding machine operator console, the Examiner cited to Bhatnagar. Bhatnagar discloses a configurable electronic controller, in which a variety of input/output connections can be reconfigured as required by a particular control application. For example, inputs may be configured as a current bias, balanced bridge, ADC, DAC, switching debouncing, filters, averaging, or the like (paragraphs 0039-0043); outputs may be configured as ON/OFF switches, PID controller, RTC, level or pulsed outputs, triac ro relay control, phase-angel, half-cycle, or integral cycle control, or the like (paragraphs 033-0038). The compute engine (0030-0032), user interface (0044-0049) and power supply (0050-0052) are configurable as well.

In order to make out a prima facie case of obviousness, the Examiner must prove two things. First, the primary reference, as modified by the Examiner, must meet each and every limitation of the claims. Secondly, there must be some motivation or suggestion in the prior art for combining the references in the first place and modifying the primary reference in the second case. In this case, the Examiner has failed to establish a prima facie case of obviousness on both counts.

First, even if there was a motivation to combine - which Applicant denies - the combination still does not result in the claimed invention. In short, the electronic controller of Bhatnagar is extensively configurable. It is not disclosed as being portable. Bhatnagar does not disclose that the configurable electronic controller can be mounted to the equipment it controls -- such as a washing machine (0059), refrigerator (0065), or HVAC (0071) -- in a portable, moveable, or relocatable manner. None of these terms appear anywhere within the

Bhatnagar application. Claim 1 explicitly recites “a portable operator console associated with said controller in data transfer relationship . . .” As Bhatnagar fails to disclose a portable operator console, the combination of Vander Groef and Bhatnagar does not teach or suggest each and every limitation of claim 1. Claims 1 and 12, and all claims depending therefrom, are patentably nonobvious over the cited art.

Furthermore, the Examiner has failed to establish a *prima facie* case of obviousness. The Examiner must show some suggestion or motivation, either in the references or in the art, to modify or combine reference teachings. The Examiner has offered only the conclusory statement that the combination would have been obvious, “because it provides a configurable way to provide flexibility and optimization of control in the intended application, at low cost.”

This statement fails as a motivation to combine Vander Groef and Bhatnagar to achieve Applicant’s invention, as would be clear to those of ordinary skill in the art. Bhatnagar’s inventive contribution is a configurable control system, which can be reconfigured to control a variety of different appliances and systems¹ without the duplication of dedicated hardware interfaces (Bhatnagar, 0007). The operator console of the present invention is a dedicated, single-purpose design, providing specific inputs to the controller within the wire winding machine. Providing a “configurable way” to supply the control inputs in a dedicated application is antithetical to good engineering practice. It needlessly adds complexity, reduces reliability, and – contrary to the Examiner’s proffered motivation – increases cost. In short, nothing in Vander Groef or the prior art would lead one of skill in the art to replace the rigidly attached operator console 152 with the complex, uselessly configurable control system of Bhatnagar to achieve the benefit of either the portable operator console of claim 1 or the remote and/or networked connections of claims 12 and 17. The Examiner has articulated no sufficient motivation in the art to do so. Indeed, the motivation articulated by the Examiner relating to providing flexibility and optimization of control and being cost effective is purely conclusionary.

¹ Among which, a wire winding machine is neither disclosed nor suggested.

Such conclusionary statements can never raise to the level of being evidence. *In re Dembizak*, 175 F.3d 994, 999, 50 U.S.P.Q. 2d 1614, 1617 (Fed. Cir. 1999). In setting forth a factual basis for motivation, the Patent Office must go beyond mere broad conclusionary statements and set forth specific understandings or technical principals that would motivate a person of ordinary skill in the art to make the combination that would render the combination obvious. *Id.*

In fact, the only thing about Bhatnagar that would be of utility in combination with Vander Groef is the network interface – which is precisely Applicant's invention as recited in claims 13 and 17. This is improper obviousness analysis, as a matter of law. "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988). "One does not start with Claim 1 and go to the prior art to see if one can piece together the [claimed invention] from the combination of older things." *Medtronic, Inc. v. Daig Corp.*, 221 USPQ 593, 606 (D. Minn. 1983).

Turning particularly to the rejection of claim 17, the Examiner noted "that it would have been an obvious step to one skilled in the art to have the data of Vander Groef retrieved off of the network rather than an internal hard drive or other storage device by methods well known by those skilled in the art." Applicant respectfully traverses this rejection as impermissible hindsight. The Examiner has made no showing that those of skill in the art of wire winding machines, at the time of Applicant's invention, would consider the programming or control of a wire winding machine from a remote terminal over a network to be obvious. "The combination of elements from non analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness." *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The only source for the idea to integrate a remote or network interface with a wire winding machine is Applicant's claims 12 and 17. "The motivation to combine references can not come from the invention itself."

Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc., 21 F.3d 1068, 30 USPQ2d 1377 (Fed. Cir. 1993).

The Examiner's statement regarding obviousness of claim 17 is a conclusory assertion, devoid of any support from prior art references or any showing from the art generally. At a minimum, the Examiner must provide "an explanation based on logic and sound scientific reasoning that will support a holding of obviousness." *Ex parte Levengood*, 28 USPQ2d 1300, 1301 (Bd. Pat. App. & Inter. 1993) (emphasis added).

To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985) (emphasis added), *See also*, MPEP § 2142 ("The examiner bears the initial burden of factually supporting any prima facie case of obviousness) (emphasis added).

In addition, the obviousness rejections are flawed because the secondary reference of Bhatnagar is not analogous art. Unquestionably, Bhatnagar is not within the field of the inventor's endeavor. The field of the inventor's endeavor is clearly wire winding machines and not electronic controllers. It is appreciated that a reference that is not within the field of the inventor's endeavor may be relied on in a patentability determination and considered as "analogous art" when a person of ordinary skill in the art would reasonably have consulted that reference in seeking a solution to the problem that the inventor was attempting to solve. See *Heidelberger, supra*. A person of ordinary skill in the art would not have consulted Bhatnagar to solve the wire winding machine problems that confronted Applicant in this case. It must be remembered that Bhatnagar is focused on providing a configurable controller that can be specifically configured to control a washing machine, refrigerator or air conditioning unit. The problem confronted by Applicant in this case was transferring information in an effective and efficient way to a wire winding machine. The problem was not one of providing controls or a

controller for the wire winding machine and certainly had nothing whatsoever to do with the focus of the Bhatnagar patent which was to provide a controller that first, could be configured in many different ways and second, could be used in conjunction with various appliances. Clearly Bhatnagar is non-analogous art and should not be considered in this case.

As the Examiner has failed to establish a prima facie case of obviousness, claims 1, 12 and 17, as well as all claims depending therefrom, are patentably nonobvious over the cited art. Accordingly, prompt allowance of all pending claims is respectfully requested.

Respectfully submitted,

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